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[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/728,000
Filing Date: December 01, 2000
Appellant(s): COMER ET AL.

John B. Phillips
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 16, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-60 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-60 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth below.

Regarding claims 1-38, the claims are rejected because the declaration is defective.

With respect to new claims 39-60, Appellant attempts to recapture subject matter surrendered during prosecution of the patent application upon which the present reissue application is based.

Regarding new claim 39 (and similarly new claims 57 and 59), the limitation that broadens the claim is as follows: "identifying a list of completed data items from a search region with the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer greater than zero, and (4) cells within the same row as the active cell and within a range of N cells from the active cell, wherein N is an integer".

The corresponding limitation in claim 1 of the patent is as follows: "identifying a list of completed data items from a search region within said spreadsheet comprising a

table of contiguous data-containing cells encompassing said active cell and bordered by empty cells".

The language that constitutes broadening is the deletion of the limitations "bordered by empty cells" and "contiguous data-containing cells encompassing said active cell". It is noted that in prosecution of the application (08/658,798), which matured into the patent (5,845,300), the claims initially before the examiner did not include the "identifying" step. It is clear from the record that the claims were amended to overcome the prior art rejection. In amendment B of application 08/658,798 (paper #8), the original prosecuting attorney amended the claims to include the "identifying" step in addition to other limitations. At pages 13-14 of the same amendment, the original prosecuting attorney identified the newly added limitation in bold-faced lettering, and stated that "none of the references cited, alone or in combination, describe identifying a list of completed data items from a search region within a spreadsheet as recited by amended claim 1". The original prosecuting attorney further elaborated on this limitation as compared to the references relied upon by the examiner in rejecting the claim. Therefore, the broadening in each of independent claims 39, 57, and 59 is germane to a prior art rejection. Such broadening constitutes impermissible recapture of previously surrendered subject matter.

The reissue oath/declaration filed with this application is defective because:

- (1) the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Appellant attempts to recapture subject matter surrendered during prosecution of the patent application upon which the present reissue is based. Thus, it appears that no reissuable error has been identified.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. The supplemental oath/declaration must include a different specific error that qualifies as a reissuable error.

(11) Response to Argument

At page 7 of the Brief, Appellant explains the prosecution of the 5,845,300 patent. In particular, Appellant explains that claim 1, as originally filed, "did not specifically define any particular search region, opting instead to broadly recite an 'association' to the active cell". Specifically, original claim 1 set forth "generating a list of completed data items from a range of said cells having an association with said active cell". Appellant then discusses the §103 rejection applied against original claim 1, and states that:

Although the original prosecuting attorney maintained that Smith did not describe "generating a list" (but rather simply searched an entire database), claim 1 was later amended . . . to add a specific reference to a search region. In particular, claim 1 was amended to add the following recitation: "identifying a list of data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells".

Appellant then provides the original prosecuting attorney's argument with respect to claim 1 versus the Smith reference:

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The search region, as recited by [amended] claim 1, comprises a table of contiguous data-containing cells encompassing the active cell and bordered by empty cells. The Smith reference does not describe searching a database using an active cell's physical association to other data items within the database, but rather, searches the entire database of previously entered data items. As a result, the search region for an active cell has no defined boundary parameters. All previously entered database items are considered to be associated with an active cell.

It is noted here that the original prosecuting attorney also argued the Novell reference with respect to the "search region" limitation—see page 13 of Amendment B (paper #8) of 08/658,798. In particular, the original prosecuting attorney stated:

Contrary to the Examiner's assertion, the Novell reference does not describe searching a database using an active cell's physical association to other data items within the database. Novell instead instructs a user to select a group of cells with one or more cells containing a seed value and the other cells being blank. The selected group of cells are not used to define a **search region** from which the blank cells will be filled with a suggested completion, but simply defines a blank range of cells to be filled. The fill information suggested by Novell's speedfill function is selected from a predefined or user defined list of data sequences Therefore, the suggested fill information is not based on identifying a list of completed data items from a search region within the spreadsheet, comprising a table of contiguous data-containing cells encompassing the active cell and bordered by empty cells, but based on matching the one or more seed value entries with the predefined or user defined list of data sequences.

Appellant argues that the added limitation only set forth one of many different "search regions" described in the specification, and that the "mistake" was that the other embodiments were not also claimed in the parent application.

The Examiner maintains that new claims 39-60 represent an attempt to recapture subject matter previously surrendered in the patent. Appellant presents "representative claim 57" to argue against the Examiner's position. In particular, the limitation at issue in representative claim 57 is:

"identifying a list of completed data items from a search region within the spreadsheet, said search region including cells within the same column as the active cell". Once again, the corresponding limitation in claim 1 is:

"identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells".

As can be readily acknowledged, the "search region" is claimed more broadly in (new) claim 57. The Examiner maintains that since the Amendment which placed claim 1 in condition for allowance specifically amended claim 1 to require that the "search region" include "a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells", then impermissible recapture is being attempted in this instance. As the Examiner pointed out above, with respect to the original prosecuting attorney's remarks concerning the Novell reference, the limitation regarding the "search region" was clearly added to overcome the rejection of the claims under §103. Since Appellant has introduced claim limitations that are broader in an aspect that is germane to a prior art rejection, then impermissible recapture exists.

Beginning at page 10 of the Brief, Appellant discusses the Law of Recapture, and cites Ball Corp. v. U.S., 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984), 4 Chisum on Patents,

§15.03[2][e] at 74-75, and Pannu v. Storz Instruments, Inc., 59 U.S.P.Q. 2d 1597 (Fed. Cir. 2001). Appellant argues that the quoted passage from Chisum "precisely describes the circumstances of the present reissue application. In particular, appellant is not attempting through the present reissue claims to recapture the scope of original claim 1 that only required an 'association' between the completed data items and the active cell. Rather, the present reissue claims (i.e., independent claims 39, 57, and 59) each define alternative "boundary parameters" for the search region . . . ". However, the Examiner again maintains that the patented claims were passed to issue based on the amendments and the original prosecuting attorney's arguments. As is argued above, the original prosecuting attorney presented arguments specifically detailing that the Smith and Novell references failed to teach that particular aspect, including the details of the search region.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Joseph H. Feild
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jhf
June 4, 2003

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